



PATENT
Docket No. 219002029000

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In the application of:

Babu J. MAVUNKEL, *et al.*

Serial No.: 09/575,060

Filing Date: 19 May 2000

For: INDOLE-TYPE DERIVATIVES AS
INHIBITORS OF p38 KINASE

Examiner: Celia C. Chang

Group Art Unit: 1625

Void date: 06/05/2003 JADD01
06/05/2003 JADD01 00000095 031952 09575060
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BRIEF ON APPEAL

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants submit herewith, **in triplicate**, their Brief on Appeal in the above-referenced application. A Notice of Appeal was filed on 28 February 2003, setting a date for filing of the Brief of 28 April 2003. A petition for an extension of time of one (1) month until 28 May 2003 is attached along with the required fee. According to the final rejection, claims 1-6, 9, 11-12, 16-27, 29-33, 36-37 and 39 were rejected and appellants appeal the rejection of these claims. Claims 22-28, 34-35 and 45-84 were objected to as dependent on rejected claims but otherwise considered allowable. Claims 40 and 41 were withdrawn from consideration. In accordance

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with 37 C.F.R. § 1.192, this Brief, along with the Appendix, is filed **in triplicate** and is accompanied by the required fee.

1. Real Party in Interest

The Real Party in Interest of this application is Scios, Inc., the assignee.

2. Related Appeals and Interferences

No other appeals or interferences that would directly affect or be directly affected by or have a bearing on the Board's decision in this Appeal are known to the appellants, the appellants' legal representative, or the assignee.

3. Status of Claims

The application was filed with 44 claims. Claims 7-8, 10, 13-15, 38 and 43-44 have been canceled; claims 40-41 were withdrawn from consideration. Claims 45-84 were added in a response to a first Office action filed 11 February 2002. Thus, claims 1-6, 9, 11-12, 16-42 and 45-84 are still pending; claims 1-6, 9, 11-12, 16-21, 29-33, 36-37 and 39 stand rejected; claims 22-28, 34-35 and 45-84 are objected to. Claims 40-41 are still pending but withdrawn from consideration. The disposition of claim 42 is not entirely clear, but it does not appear to be rejected.

In the pending claims remaining, claim 1 has been amended twice, once in response to a Restriction Requirement and once in response to the first Office action; claims 2-6 are as originally filed; claim 9 was amended in response to the first Office action; claims 11-12 are as originally filed; claims 16-17 were amended in response to the first Office action; claims 18-29 stand as originally filed. Claim 30 was amended in response to the first Office action and claims 31-42 are as originally filed; claims 45-84 were added in response to the first Office action - claims 45-70 in a response initially filed and claims 71-84 in a supplementary response.

4. Status of Amendments

An amendment proposed to claim 1 after final rejection was not entered according to an Advisory Action mailed 18 February 2003.

5. Summary of the Invention

The invention is directed to a genus of compounds of a specified structural formula as shown in claim 1 which compounds are useful in treating inflammation or proliferative conditions as well as treating conditions associated with cardiac failure and Alzheimer's disease. It is believed that these conditions are mediated by overactivity of p38 α kinase. (See page 3 of the specification, lines 1-25 and page 4, lines 1-20.) Claim 1 as presently pending is a subset of the genus originally proposed partly as a result of a restriction requirement which required limitation to compounds wherein Z^1 as shown on page 3 is N and wherein l and k are both 1. In addition, L^1 and L^2 defined on page 3 simply as linkers are further defined in the claim as presently pending, they are defined on page 6, line 25-page 7, line 11. The dependent claims are limited to various embodiments of the defined substituents.

All pending claims through claim 37 are directed to defined chemical compounds; claim 39 is directed to a pharmaceutical composition, and claims 40-41 (withdrawn from consideration) depend therefrom but require additional therapeutic agents. Claim 42 is directed to a method to treat rheumatoid arthritis using a compound of claim 1. New claims 45-84 are all directed to compounds.

6. Issues

One issue which lies at the root of a rejection under 35 U.S.C. § 103 over Takahashi (JP 09/124631), is whether on page 5, line 16, which defines alkylene as $(CH_2)_n-R$, the generic "n" noted in the formula (which obviously mistakenly contains an extra R) would be interpreted

by the ordinarily skilled reader to be one and the same as the “n” defined on page 3 that denotes the number of R³ substituents in the α ring of formula (1). If the reader were to interpret the “n” on page 5 as clearly intended, then the compounds disclosed in Takahashi would even more clearly differ from the compounds presently claimed.

The second issue is patentability of the rejected claims over the cited documents. The compounds claimed clearly differ from those in the cited document by virtue of the presence of O rather than NR⁷ in the β ring of formula (1).

The third issue relates to rejoinder of claims 40-41.

7. Grouping of Claims

Although appellants believe that some claims, such as claims 4-6 require substituents that distance them even farther from Takahashi than, for example, claim 1, because the claims are so clearly not suggested by the cited document, it is considered pointless to attempt to group them.

8. Argument

A. Alkylene and alkenylene are legitimately defined as containing 1-4C.

Claim 1 as presently pending defines L¹ and L² as alkylene or alkenylene each having 1-4C. The designation of 1-4C was objected to as new matter on the basis that the definition of “alkylene” on page 5, line 16, was “(CH₂)_n-R”; applicants pointed out, apparently without objection, that the “R” was clearly an error. The Examiner takes the position that the “n” in this formula must be the same as the “n” used to define the number of occurrences of R³ in the α ring of formula (1).

Appellants can only state that the ordinarily skilled artisan, being used to the use of “n” as a generic designation for a number in general as in the “nth degree” or “where x occurs n

times” would interpret “n” in this location as such a generic, meaning some number in general. Certainly the skilled artisan would not interpret “n” in this context as including 0, because then the alkylene would not exist at all. It seems absurd on its face to assume that the “n” used on page 5, line 16, has the same numerical value as that stipulated for “n” in the defined formula (1) of claim 1.

Further, in all locations where substituents, such as alkyl, that are related to alkylene - *i.e.*, the monovalent form rather than the divalent form - are referred to, the number of carbons is 1-4. See, for example, page 9, line 4, page 9, line 23, page 10, line 25. If this specificity is objected to since “alkylene” as 1-4C is not present *in haec verba* in the application, appellants are willing to delete that specificity from the claim language; however, this offer in response to final rejection was refused.

In any event, it is not seen how alkylene or alkenylene can be present and contain less than 1C. If it is present at all, it must have at least one carbon in the chain (actually alkenylene must have at least 2C).

In sum, appellants believe it is apparent that L¹ and L² must actually be present in the molecule, and cannot simply be a bond based on the disclosure of the specification.

B. The Rejected Claims Are Not Obvious Over Takashima Even in Combination with Patani.

First, as has been argued extensively, in the compounds of Takashima (JP 09/124631), a phenyl group is linked directly to the nitrogen of a piperazine ring without a linker. Assuming that appellants prevail in their argument above, at least one carbon atom must intervene between Ar and the piperazine ring in the compounds of claim 1. There is no document suggesting that a spaced aromatic moiety from a piperazine ring would be obvious or suggested by compounds

where an Ar is directly linked to the piperazine. For this reason alone, the compounds of formula (1) are not obvious over the cited document.

A second reason that the compounds of formula (1) are not obvious is that there is no equivalent to CA or CR⁸A in ring β . The Examiner points to the compound set forth on page 6 of the cited document which has as this substituent CH₂-NH-NHCOCH₃. However, the claims specifically require a carbonyl group in this substituent in place of the CH₂ (methylene). The Office cites Patani as putatively showing that CONH and CH₂NH are bioisosteres in Table 48. However, the mere fact that these may be isosteres does not render CONH obvious over CH₂NH₂ since the biological function may be other than steric. C=O is a reactive group; CH₂ is not.

Third, the compounds of the invention are not obvious over Takashima even combined with Patani because *the invention compounds are essentially indole derivatives whereas the compounds of the cited document are benzofurans*. Appellants realize that this could have been pointed out earlier; however, their undersigned representative took the Examiner at her word that Takashima disclosed all the elements of the claims except the linker (meaning Z²) “has a methylene chain instead of a carbonyl group” (assuming L² could be a bond - which it cannot). Had the structure been examined more closely, rather than focusing on the points raised by the Examiner, it would have been evident that the compounds of the cited document are of a different type entirely. The presence of oxygen rather than NR⁷ in the counterpart to the α/β ring system clearly defines a different class of compounds.

Thus, for at least three reasons, the compounds of claim 1, and therefore its dependent claims, are not suggested by Takashima even in combination with Patani.

Copies of Takashima and Patani are enclosed as Exhibits B and C.

C. Claims 40-41 should be rejoined.

Appellants are aware that restriction requirements are petitionable; however, the basis for this restriction requirement was the asserted unpatentability of claim 39 from which claims 40 and 41 depend. (Claim 39 is a pharmaceutical composition comprising as active ingredient the compound of claim 1.) Since claim 39 is itself patentable, claims 40 and 41 which depend therefrom and simply require an additional active ingredient must be patentable as well and there is no reason to judge them separately. Accordingly, appellants request that these claims be rejoined.

CONCLUSION

When properly interpreted, claim 1 requires the presence of linkers between piperazine and both an indole ring system and an aromatic moiety. The documents cited against the rejected claims are benzofuran systems (not indoles) and do not contain a linker between piperazine and an aromatic system. Accordingly, all pending claims are believed allowable and reversal of the outstanding rejection is respectfully requested.

9. Appendix

An Appendix containing a copy of the claims as currently pending is attached.

The Assistant Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. § 1.17 that may be required by this Brief, or to credit any overpayment, to Deposit Account No. 03-1952.

Respectfully submitted,

Dated: May 28, 2003

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